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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,443	09/12/2003	Ryan W. Cuddy	0112300-1536	7823

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EXAMINER

NGUYEN, KIM T

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,443

Applicant(s)

CUDDY ET AL.

Examiner

Kim Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/14/05, 3/17/05, 9/1/05</u> | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Examiner acknowledges receipt of the preliminary amendments on 1/14/05, 7/20/05 and 9/1/05. According to the amendment, claims 1-40 are pending in the application.

Claim Objections

1. Claims 1, 16, 31, 35 and 38 are objected to because of the following informalities:
 - a) In claim 1, line 6; claim 16, line 7; claim 31, line 7; and claim 35, line 5, the claimed limitation "the generation" should be corrected to "a generation".
 - b) In claim 35, lines 3-4 of limitation (d); and claim 38, lines 3-4 of limitation (d), the claimed limitation "the number of designated symbols" should be corrected to "a number of the designated symbols".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 35-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) In claim 35, lines 2 and 4 of limitation (d); and claim 38, lines 2 and 4 of limitation (d), the claimed limitation "said event" is ambiguous. It is not clear if "said event" refer to the "trigger event" in line 5, or the "subsequent event" in line 14.
- b) Claims 36-37 and 39-40 are rejected as being dependent on the rejected base claim.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 5. Claims 1-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-69 of copending Application No. 10/241,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application No. 10/241,255 discloses a gaming device including the same subject matter such as repeatedly reactivating the reels when a trigger event occurs as disclosed in claims 1-40 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US 6,491,584) in view of Glasson (US 6,290,600).

As per claim 35, Graham discloses a gaming device comprising a game operable upon a wager by a player, a plurality of reels with a plurality of symbols and a triggering event (col. 2, lines 39-48 and 61-67; and col. 3, lines 7-8); and a processor operable after the triggering event for generating symbols on the reels without an additional wager and awarding the player for any winning combinations (col. 3, lines 9-13); repeating steps (a) and (b) until a designated symbol occurs on the reels (trigger condition occurs); providing a subsequent event (a further series of free games is awarded) (col. 3, lines 33-36); and beginning step (a) again. Graham does not explicitly disclose including a terminating event in the bonus sequence event. However, Glasson discloses including a terminating event (col. 7, lines 4-9 and 46-47). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a terminating symbol as a result of the bonus sequence

event as taught by Glasson in the gaming device of Graham in order to inform the player that the bonus game is over.

As per claim 36-37, playing a game through an Internet network would have been well known to a person of ordinary skill in the art at the time the invention was made.

As per claim 38-40, refer to discussion in claims 36-37 above.

Allowable Subject Matter

8. Claims 1-34 would be allowable if a filed terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the double patenting rejection, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to show or fairly suggests a gaming device as set forth in independent claims 1, 16 and 31 in which a processor operable after the triggering event to (a) cause a generation of a plurality of the symbols on the reels without an additional wager by the player, (b) provide the player any award associated with any winning combinations of generated symbols on the reels from the generation, (c) repeat (a) and (b) until one of the wild symbols is generated on one of the reels in the generation, and (d) if one of the wild symbols is generated on one of the reels in said generation, locking the position of the reel with the wild symbol for a designated number of further generations of symbols on a designated number of other reels,

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wherein (i) if a designated number of other wild symbols are generated on the reels in the designated number of further generations, unlocking the position of the reels with

the wild symbol and returning to (a), and (ii) if a designated number of other wild symbols are not generated on the reels in the designated number of further generations, terminating any further generations of the reels until another wager is made in the game.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

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Date: October 5, 2005



Kim Nguyen
Primary Examiner
Art Unit 3713